IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Sethuraman Suresh et al.

Serial No.: 08/923,612

Filed: September 4, 1997

For: System and Methods for
Synchronizing Information Among
Disparate Datasets

Examiner: Channavajjala, S.

Art Unit: 2776

REPLY BRIEF

Box AF, Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REPLY BRIEF ON BEHALF OF SETHURAMAN SURESH ET AL.:

    This is a Reply Brief in response to the Examiner's Answer mailed September 18, 2000. This brief is submitted in triplicate in support of Appellants' appeal.

General

Appellant confirms that claims 18-20 were intended to be included in Group I. The omission of claims 18-20 from Group I was inadvertent.

New Points of Argument

The Examiner's Answer stated new points of argument that had never been set forth in any of the previous office actions regarding the subject application. Thus, Appellants would like the opportunity to address these new points of arguments, taking advantage of Appellants' opportunity to file a reply brief under 37 C.F.R. § 1.193(b). The following will identify and address each new point of argument raised in the Examiner's Answer as they relate to Groups I and II.

A. Group I claims

In Appellants' discussion of the claims of Group I, the particular advantage afforded by Appellants' invention is summarized: to allow a given data record on one device to be transferred to a totally different device in a system-independent manner. This would allow data records that are native to one device, for instance, to be synchronized with corresponding data records on a totally different device. Apart from the foregoing advantage, Appellants' pending claims include specific claim limitations corresponding to specific features present in Appellants' invention that the rise to the foregoing advantage. These claim limitations are highlighted on page 10 of Appellants' brief. Notwithstanding Appellants' detailed explanation of the specific claim limitations stating specific features that enable Appellants' invention to achieve the above-mentioned purpose, the Examiner apparently dismisses Appellants' contention in its entirety based on his that: "Applicant's arguments based on the specification, not in the claim language."

The Examiner's position is surprising given the explicit enumeration in Appellants' brief of the particular claim limitations present in Appellants' Group I claims that are believed to distinguish claims of that group over the art. This treatment is now

repeated below, with emphasis added to highlight the very specific claim limitations for Group I claims that are believed to distinguish over the art.

> The **claim limitations present in Appellants' claims of this group** bring this distinction to the forefront. Appellants' **claim 1 requires** that "each information record of the source dataset is assigned a globally unique identifier **that is independent of either of the devices.**" Still further, the **claim requires** that the globally unique identifier be "maintained in a **device-independent record map** that allows the globally unique identifier to be traced back to a specific information record **regardless of which device** the specific information record resides." In this manner, the record map provides a means of identifying records to the synchronization system's logic, **independent** of how a record is identified within its own data set. **This approach allows a given information record to be transferred from one device, say, a cellular phone, to a completely different device, say, a desktop computer, regardless of the fact that the receiving device does not support the original format for the information record.** On the other hand, if one were simply transferring information records among like devices, such as like server computers as done by Olds, there would be no need to fashion an identifier that was independent of those devices; instead, one can simply rely on whenever system-dependent unique identifier was already provided by that system.
> (Appellants' brief, at p. 10; bold emphasis added)

To be sure, the very specific features that Appellants rely on to distinguish the claimed invention over the art are set forth in the claims as explicitly enumerated claim limitations. At the same time, it is not an appropriate position for the Examiner to dismiss Appellants' arguments as being based on the specification, not claims, when instead Appellants' arguments are based on specific claim limitations and only mention the advantages that those limitations give rise to for the purpose of understanding the relevance of those claim limitations with respect to the prior art (particularly when that art is based on purported "obvious" combinations). The Examiner's apparent position that those advantages cannot be mentioned in Appellants' arguments unless those advantages themselves are also specifically enumerated in the claim language appears misplaced.

Turning to the Examiner's treatment of Appellants' mechanism for achieving device independence, the Examiner only addresses the limitation of "a globally unique identifier that is independent of either of the devices." Here, the Examiner states that Olds meets this limitation by the following two teachings:

(1) Olds at col. 3, lines 25-30:

> When an object is created within a replica it is assigned a unique identifier relative to its sibling objects, such that no two siblings in any replica of the partition have the same relative identifier. The relative identifier contains its replica number and is therefore guaranteed to be unique among all of the sibling objects created in all replicas of that partition.

(2) Olds at col. 6, lines 64-67:

> The database-wide object identifier identifies the target object relative to all other objects in the database. That is, no two objects in the database have the same database-wide object identifier.

However, as set forth in Appellants' appeal brief, Appellants' claim 1 also sets forth the limitation that the globally unique identifier be "maintained in a **device-independent record map** that allows the globally unique identifier to be traced back to a specific information record regardless of which device the specific information record resides." The claimed device-independent record map provides the particular *advantage*, for example, of allowing identification of records (to the synchronization system's logic) independent of how a record is identified within a given device (or even within its own data set). As to this specific record-map limitation, the Examiner offers no art and no explanation, and thus fails to establish prima facie obviousness under Section 103.

B. Group II claims

In regards to Appellants' filter claim limitation, the Examiner states that Buchanan's use of SQL fully anticipates that limitation, on the basis that SQL may be used to filter information. However, Appellants do not claim a filter in the abstract, nor do they simply add a filter limitation on top of the other existing claim limitations. Instead,

Appellants' claims specify how a specific filter is applied in regards to the synchronization process. For instance, **claim 15** specifies that the filter "comprises an **outbound** filter applied to information records **prior to creation** of the synchronization set." **Claim 16**, on the other hand, specifies that the filter "comprises an **inbound** filter applied to information records **after creation** of the synchronization set." Under Section 103, the Examiner must show, among other things, that the prior art reference (or references when combined) teach or suggest <u>all</u> the claim limitations. The Examiner's showing of a filter per se, be it SQL or some other type of filter, still leaves unaddressed Appellants' claim limitations of **inbound** and **outbound** filters, which may be applied at strategic points during Appellants' claimed synchronization process. By again leaving a claim limitation unaddressed, the Examiner has failed to establish prima facie obviousness under Section 103.
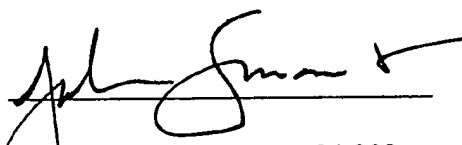
<u>Conclusion</u>

For the reasons stated, it is respectfully submitted that the claims set forth a patentable advance over the art. If a telephone conference would in any way expedite the prosecution of this application, Appellant's undersigned attorney can be reached at 408-395-8819.

   This brief is submitted in triplicate.

Respectfully submitted,

Date: November 20, 2000

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